

MAY 23 2005

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Stuart Taylor et al.

Confirmation No.: 8469

Application No.: 09/882,625

Examiner: P. E. Elisca

Filing Date: June 15, 2001

Group Art Unit: 3621

Title: SYSTEM AND METHOD FOR PROVIDING E-SERVICES

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on March 22, 2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

() one month	\$120.00
() two months	\$450.00
() three months	\$1020.00
() four months	\$1590.00

() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of \$500.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

Stuart Taylor et al.

By

Michael J. Fogarty, III

Attorney/Agent for Applicant(s)

Reg. No. 42,541

Date: May 23, 2005

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(X) I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV629197552US, in an envelope addressed to: MS Appeal Briefs - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Date of Deposit: May 23, 2005

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HEWLETT-PACKARD COMPANY
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Docket No.: 10013451-1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Stuart Taylor et al.

Application No.: 09/882,625

Confirmation No.: 8469

Filed: June 15, 2001

Art Unit: 3621

For: SYSTEM AND METHOD FOR PROVIDING
E-SERVICES

Examiner: P. E. Elisca

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on March 22, 2005, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying
TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R.
§ 41.37 and M.P.E.P. § 1206:

- | | |
|-------|---|
| I. | Real Party In Interest |
| II | Related Appeals and Interferences |
| III. | Status of Claims |
| IV. | Status of Amendments |
| V. | Summary of Claimed Subject Matter |
| VI. | Grounds of Rejection to be Reviewed on Appeal |
| VII. | Argument |
| VIII. | Claims |

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IX. EVIDENCE
X. RELATED PROCEEDINGS
Appendix A Claims

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is: Hewlett-Packard Development Company, a Texas Limited Liability Partnership having its principal place of business in Houston, Texas.

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 18 claims pending in application.

B. Current Status of Claims

1. Claims canceled: none
2. Claims withdrawn from consideration but not canceled: none
3. Claims pending: 1-18
4. Claims allowed: none
5. Claims rejected: 1-18

C. Claims On Appeal

The claims on appeal are claims 1-18

IV. STATUS OF AMENDMENTS

Applicant did **not** file an Amendment After Final Rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Embodiments of the present application describe a multi-application terminal for supplying payment and non-payment related services (page 8 and 100 of the Figure). The terminal is described as including a memory storing a plurality of payment and non-payment applications (page 8) and a memory management unit (page 8 and 120 of the Figure) for separating the applications in said memory (page 8 and 130 of the Figure). This permits the non payment applications to exist with the payment application without requiring additional certification (page 8). The terminal further includes a processor for executing one or more applications (page 8 and 110 of the Figure). In operation, the memory management unit is operable to assign a protected region within the memory to each application being executed by the processor, and the payment applications are operable to provide payment related services over a secured network (page 9 and 300 of the Figure). The non-payment applications are operable to provide non-payment related services over an open network (page 9 and 300 of the Figure).

Additional embodiments of the present application incorporate a multi-application terminal into system for providing credit card verification at a point of sale (pages 9-10 and 10 of the Figure). An example system includes a terminal (pages 9-10 and 100 of the Figure) for accepting data from a credit card in conjunction with point of sale purchase information, and a means, such as an internet connection to an e-service provider, for providing acceptance information to said point of sale pertaining to said purchase (pages 9-10 and 300 of the Figure). The terminal includes means, such as a public key infrastructure application, that is responsive to information provided to said terminal from a user other than information provided by controlling applications other than said point of sale acceptance information in said credit card (pages 9-10 and 140 of the Figure).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. The Rejection of Clams 1, 2, 6-10, and 13-18 in light of *Tal* and *Nozue*
- B. The Rejection of Clams 3-5, 11, and 12 in light of *Tal*, *Nozue*, and *Ishiguro*

VII. ARGUMENT

While not specifically at issue in this appeal, substantial prosecutorial irregularities exist in the present case, and the Board needs to be aware of them as they significantly affect the arguments of this appeal.

The full rejection of the pending claims is not yet of record, because the Final Office Action dated November 22, 2004 (hereinafter "Final Action") omits significant portions of the Examiner's remarks. Page 5 of the Final Action is a recitation of case law relating to the propriety of various sources of motivation, and concludes at the end of a paragraph. The top of page 6 of the Final Action, in contrast, begins in mid-sentence and in the middle of listing the latter portions of the Examiner's response to the Appellant's response of August 23, 2004 (hereinafter "Response to First Action"). In the Response dated January 10, 2005 (hereinafter "Response to Final Action"), the Appellant pointed out the omission, and asked the Examiner to provide the Appellant with the omitted portions of the rejections and to provide the Appellant a full and fair opportunity to respond.

The Examiner's Advisory Action dated February 16, 2005 (hereinafter "Advisory Action") ignored the Appellant's requests, and further confused the issue by indicating that an amendment had been made to the claims. The Appellant did not submit any amendments in their Response to Final Action, but, since the Advisory Action contained no comments, it is impossible to tell whether or not the amendment indication is inadvertent.

These irregularities place the Appellant in an awkward position. Without knowing the full nature of the Examiner's rejection, and without knowing if the pending claims have been amended by mistake, the Appellant must "guess" as to the actual issues of rejection. The arguments below reflect the state of the claims and the nature of the rejections as the Appellant understands them.

A. The Rejection of Claims 1, 2, 6-10, and 13-18 in light of *Tal* and *Nozue*

The Office Action dated May 24, 2004 rejected claims 1, 2, 6-10, and 13-18 as obvious in light of a combination of *Tal*, U.S. Patent No. 6, 535, 856 (hereinafter *Tal*), and *Nozue et al.*, U.S. Patent No. 5,890,189 (hereinafter *Nozue*). In their Response to First Action, the Appellant demonstrated that the Examiner had yet to establish a prima facie case of obviousness. In the Final Action, the Examiner repeated the original rejection, and attempted to respond to Appellant's arguments. However, as discussed above, significant portions of those arguments were omitted. The Appellant's Response to Final action pointed out these omissions, and demonstrated that no prima facie case could be established using the combination of *Tal* and *Nozue*.

The Examiner bears the burden of first establishing a prima facie case of obviousness. See *In re Rinehart*, 531 F.2d 1048 (CCPA 1976). To establish that prima facie case, the Examiner's rejection must meet three criteria. First, there must be some motivation for combining the references used, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the combination must have had a reasonable likelihood of success. Third, when combined, the references must teach or suggest each and every limitation of the rejected claims. See *in re Vaek*, 947 F.2d 488 (Fed. Cir. 1991). The Appellant respectfully asserts that the Examiner's rejection using the combination of *Tal* and *Nozue* does not establish a prima facie case, because, among other things, this combination does not teach or suggest each and every element of the rejected claims.

Claim 1 recites:

a memory storing a plurality of payment and non payment applications;

a memory management unit for separating said applications in said memory, thereby permitting said non payment applications to exist with said payment application without requiring additional certification

The Appellant respectfully points out that claim 1 requires "a memory storing a plurality of payment and non payment applications," and respectfully asserts that *Tal* does not teach or suggest a memory storing applications. Instead, *Tal* teaches database 34.n, which is a

database storing data entries. Nor does *Tal* disclose a “memory management unit.” The Examiner has repeatedly attempted to equate database 34.n with a “memory management unit.” But as the Appellant has demonstrated in both its responses, the claim 1 “memory management unit” must be capable of “separating said applications in said memory, thereby permitting said non-payment applications to exist with said payment application without requiring additional certification.” Database 34.n is not described by *Tal* as being capable of performing these tasks. Rather, *Tal* portrays database 34.n as a database of the type well known in the art, and performing the task of merely holding separate data entries. While not relied on by the Final Action to do so, the Appellant notes that *Nozue* does not teach these limitations missing from *Tal*. Therefore, the Examiner’s rejection of claim 1 does not establish a prima facie case, and the Appellant respectfully asks this Board to overturn the rejection of claim 1.

In both the Response to First Action and Response to Final, the Appellant demonstrated the examiner’s failure to establish a prima facie case of rejecting claim 8 as well. Claim 8 recites “storing a plurality of payment and non-payment applications in separate memory locations within said terminal;” a limitation neither taught nor suggested by the combination of *Tal* and *Nozue*. The Examiner appears to be contending that database 34.n in FIGURE 3 of *Tal* incorporates this limitation. However, the Applicant respectfully asserts that no element of *Tal* performs the action of storing a plurality of payment and non-payment applications. Nor can such actions be inferred from the existence of database 34.n, as this element is taught by *Tal* to be a mere database storing individual data entries, not applications. Although the Examiner has not relied on it to do so, *Nozue* does not appear to teach or suggest this limitation either. Therefore, the combination of *Tal* and *Nozue* does not teach or suggest every limitation of claim 8, and the Examiner has failed to establish a prima facie case. The Appellant respectfully asks this Board to overturn the rejection of claim 8.

In both the Response to First Action and Response to Final, the Appellant demonstrated the examiner’s failure to establish a prima facie case of rejecting claim 15 as well. Claim 15 recites “a terminal for accepting data from a credit card in conjunction with point of sale purchase information,” and neither *Tal* nor *Nozue* teach or suggest this limitation. In the Final Action, the Examiner contends that *Tal* “discloses this limitation in col. 3, lines 44-59, specifically communication module 22 which includes one or more

cards.” This citation in *Tal*, however, shows that a communication module links the service center to the network, and that the “cards” referred to by the Final Action are computer communication cards coupled to a PCI bus. Such a module cannot be said to be “a terminal for accepting data from a credit card in conjunction with point of sale purchase information,” and computer communications cards are not credit cards. Therefore, the combination of *Tal* and *Nozue* does not teach or suggest every limitation of claim 15, and the Examiner has again failed to establish a prima facie case. The Appellant respectfully asks this Board to overturn the rejection of claim 15.

Claims 2, 6, 7, 9, 10, 13, 14, and 16–18 depend either directly or indirectly from claims 1, 8, or 15. Although claims 2, 6, 7, 9, 10, 13, 14, and 16–18 all recite limitations that make them patentable in their own right, they are at least patentable for depending from a patentable base claim. Therefore, the Appellant respectfully asks this Board to overturn the rejections to claims 2, 6, 7, 9, 10, 13, 14, and 16–18 as well.

B. The Rejection of Claims 3-5, 11, and 12 in light of *Tal*, *Nozue*, and *Ishiguro*

Claims 3–5, 11, and 12 are rejected as obvious in light of *Tal*, *Nozue*, and in further light of *Ishiguro et al.*, U.S. Patent No. 5,446,796 (hereinafter *Ishiguro*). However, claims 3–5 depend from claim 1, and claims 11 and 12 depend from claim 8. Thus each of claims 3–5, 11, and 12 inherits all of the limitations of its respective base claim. As argued above, the combination of *Tal* and *Nozue* does not teach or suggest “a memory storing a plurality of payment and non-payment applications,” as recited by claim 1. Nor does the combination teach or suggest “storing a plurality of payment and non-payment applications in separate memory locations within said terminal,” as recited by claim 8. Although the Examiner does not rely on it to do so, *Ishiguro* does not appear to teach or suggest these limitations either; thus, the combination of *Tal*, *Nozue* and *Ishiguro* does not teach or suggest every limitation of claims 3–5, 11, and 12. Therefore, the Examiner has failed to establish a prima facie case, and the Applicant respectfully asks this Board to overturn the rejection of claims 3–5, 11, and 12.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A.

IX. EVIDENCE

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

X. RELATED PROCEEDINGS

No related proceedings are referenced in II. above, or copies of decisions in related proceedings are not provided, hence no Appendix is included.

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Date of Deposit: May 23, 2005

Typed Name: Joy Perigo

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Respectfully submitted,

By Michael J. Fogarty, III

Michael J. Fogarty, III

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Date: May 23, 2005

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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 09/882,625

1. (Previously Presented) A multi-application terminal, comprising:
a memory storing a plurality of payment and non-payment applications;
a memory management unit for separating said applications in said memory, thereby permitting said non-payment applications to exist with said payment application without requiring additional certification; and
a processor for executing one or more applications;
wherein:
said memory management unit is operable to assign a protected region within said memory to each application being executed by said processor; and
said payment applications are operable to provide payment related services over a secured network and said non-payment applications operable to provide non-payment related services over an open network.
2. (Original) The terminal of claim 1 wherein said memory management unit terminates an application or shuts down said terminal if it is determined that said application is accessing memory outside its assigned region.
3. (Previously Presented) The terminal of claim 1 wherein said processor comprises:
control for authenticating applications to prevent execution of an unauthorized application on said terminal.
4. (Original) The terminal of claim 3 wherein said control is public key infrastructure based software.
5. (Original) The terminal of claim 1 wherein said non-payment applications provide e-services over the Internet.
6. (Original) The terminal of claim 5 wherein said e-services can be accessed by a consumer using a personal digital device over a wireless connection.

7. (Original) The terminal of claim 6 wherein said personal digital device comprises at least one of the following: a cell phone, a PDA, and a beeper.

8. (Previously Presented) A method for providing a plurality of services on a payment terminal, said method comprising:

storing a plurality of payment and non-payment applications in separate memory locations within said terminal, thereby permitting said non-payment applications to exist with said payment application without requiring additional certification;

assigning a protected region within said memory to each application running on said terminal;

selecting at least one application to be executed on said terminal by an operator; and

executing said selected application on said terminal to provide service associated with said selected application; and

wherein said payment applications provide payment related services over a secured network and said non-payment applications provide non-payment related services over an open network.

9. (Previously Presented) The method of claim 8 further comprising:

terminating said selected application if it is determined that said selected application is accessing memory outside its assigned region.

10. (Previously Presented) The method of claim 8 further comprising:

shutting down said terminal if it is determined that said selected application is accessing memory outside its assigned region.

11. (Previously Presented) The method of claim 8 further comprising:

authenticating applications to prevent execution of unauthorized application on said terminal.

12. (Original) The method of claim 8 wherein said non-payment applications provide e-services over the Internet.

13. (Original) The method of claim 12 wherein said e-services can be accessed by a consumer using a personal digital device over a wireless connection.

14. (Original) The method of claim 13 wherein said personal digital device comprises at least one of the following: a cell phone, a PDA, and a beeper.

15. (Previously Presented) A system for providing credit card verification at a point of sale, said system comprising:

a terminal for accepting data from a credit card in conjunction with point of sale purchase information; and

means controlled by a remote system for providing acceptance information to said point of sale pertaining to said purchase; and

wherein said terminal includes means operative in response to information provided to said terminal from a user other than information provided by controlling applications other than said point of sale acceptance information in said credit card.

16. (Original) The system of claim 15 wherein said other provided information comes to said terminal under exclusive control of said user.

17. (Original) The system of claim 15 wherein said other provided information is provided by at least one of the following: a cell phone, a PDA, or a beeper.

18. (Original) The system of claim 15 further including means for maintaining applications which control point of sale acceptance separate from said other applications.